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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,343	04/06/2001	Andrew Joseph Dillon	029641R	1716

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EXAMINER

WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,343

Applicant(s)

DILLON ET AL.

Examiner

Eric F Winakur

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 15, 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant is notified that the amendment filed April 6, 2001 presents amendments that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. The claims have been examined taking the amendments into account. The claim amendments of the preliminary amendment must be refiled and any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 5, 7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Diab et al. Diab et al. teach an optical probe (Figures 29A, 29B) that includes a rigid, opaque saddle (cradle member) formed from black plastic (Figures 16, 18, 20; column 15 - 16) that includes a photodetector within a chamber. The optical probe further

Art Unit: 3736

includes a flexible, adhesive element (column 23, line 50 - column 24, line 34) that contains an emitter. In use, the emitter is aligned opposite the detector and flanges from the probe adhesively attach to a subject's finger without stressing the fingertip.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diab et al. as applied to claims 1, 2, 5, 7, and 8 above. Diab et al. teach that their cradle is formed from a rigid, opaque material, such as black plastic but do not specifically teach that this is a molded polyolefin plastic, or polypropylene in particular. However, these are merely well known plastic materials. It would have been within the skill level of the art at the time of the invention to implement the device of Diab et al. with a cradle constructed from polypropylene, since Diab et al. teach that the cradle is constructed from black plastic and it has generally been held to be within the skill level of the art to identify and use well known materials that meet the requirements of a teaching.

5. Claims 10 - 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diab et al. in view of Swedlow et al. Diab et al. teach an optical probe, as described in paragraph 2 above, but do not teach that the emitter can be located in the cradle and the detector located in the flexible web member. Swedlow et

Art Unit: 3736

al. teach a similar probe that has an emitter in a flexible web member and a photodetector in a pad or may have the elements in a reversed arrangement (column 3, lines 34 - 37; column 5, lines 10 - 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Diab et al. to have the emitter in the cradle and the photodetector in the flexible member, since Swedlow et al. teach that this is merely an equivalent arrangement for elements in an optical probe to that provided in Diab et al. With regard to claims 12 and 13, Diab et al. teach that the cradle is constructed from black plastic, but do not teach the specific materials that this is formed from. As discussed in paragraph 4 above, it would have been within the skill level of the art to determine which well known materials would fulfill the requirements of the teaching and implement the cradle with such well known materials as molded polyolefin plastic or polypropylene, as set forth in the claims.

Allowable Subject Matter

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest a probe having an electrical conductor channel formed within the concave surface of the cradle member or having a double-sided adhesive layer applied to the concave surface of the cradle member.

7. Claims 6, 9, 15, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reissue Applications

Art Unit: 3736

8. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. It is noted that Applicant states that they have returned the original patent to the Patent Office on April 14, 1999 in the parent application. Upon inspection of the parent application file, Applicant's transmittal cover sheet (a copy of which was included in the instant application) was found but the original patent was not found. Applicant is requested to supply the original patent if it had been returned to him subsequent to the April 14, 1999 filing or provide a statement that it is lost or inaccessible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703/308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703/308-0758 for regular communications and 703/308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0858.



Eric F Winakur
Primary Examiner
Art Unit 3736

February 21, 2002